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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/696,635	10/25/2000	Kestutis Tautvydas	11536-001001/55190USA8A	4398

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EXAMINER

JIANG, SHAOJIA A

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 01/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/696,635

Applicant(s)

TAUTVYDAS ET AL.

Examiner

Shaojia A. Jiang

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This Office Action is a response to Applicant's response filed on November 13, 2002 in Paper No. 16. Currently, claims 31-40 are pending in this application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 31-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andrews et al. (5,460,833) in view of Viccaro et al. (5,188,822) and Carmody (5,145,685) for reasons of record stated in the Office Action dated August 13, 2002.

Applicant's remarks filed on November 13, 2002 in Paper No. 16 with respect to this rejection made under 35 U.S.C. 103(a) in the previous Office Action (August 13, 2002) have been fully considered but are not deemed persuasive as to the nonobviousness of the claimed invention over the prior art for the following reasons.

Applicant's assertion that "there is no teaching or suggestion in Andrews that would have led one of ordinary skill in the art to modify the formulations of Andrews to substitute either benzoic acid or salicylic acid as an enhancer for use with fruit, vegetables and seeds", has been considered but is not found persuasive. Applicant is requested to note that it is well settled that "intended use" of a composition, formulation,

or product, e.g., "as an enhancer for use with fruit, vegetables and seeds", will not further limit claims drawn to a composition, formulation, or product. See, e.g., *Ex parte Masham*, 2 USPQ2d 1647 (1987) and *In re Hack* 114, USPQ 161. Moreover, the instant claims are merely drawn to an antimicrobial formulation.

Applicant's assertions that there is no teaching or suggestion or in knowledge available generally to one skilled in the art that antimicrobial composition would retain the same antimicrobial activity in Andrews by substituting benzoic or salicylic acid and a reasonable expectation of success, and that secondary references do not cure the deficiencies of Andrews, have been considered but is not found persuasive for the following reasons.

First, Andrews teaches that different antimicrobial agents broadly are known to be useful in antimicrobial compositions (see col.1 lines 43-46). Secondly, Viccaro et al. (5,188,822) and Carmody (5,145,685) have been cited by the examiner primarily for their teachings that both benzoic acid and salicylic acid are known antimicrobial agents and also known to be useful in the antimicrobial compositions. Thirdly, it has been held that it is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for same purpose in order to form a third composition that is to be used for the very same purpose; idea of combining them flows logically from their having been individually taught in prior art. *In re Kerkhoven*, 205 USPQ 1069, CCPA 1980. See MPEP 2144.06. In the instant case, as discussed in the set forth 103(a) rejection, both benzoic acid and salicylic acid are known antimicrobial agents and also known to be useful in the antimicrobial compositions according to the prior art.

Therefore, one of ordinary skill in the art would have reasonably expected that employing or adding benzoic acid or salicylic acid, known useful for the same purpose, i.e., antimicrobial, in the antimicrobial composition of Andrews et al. would improve the antimicrobial effect for the composition of Andrews with a reasonable expectation of success, absent evidence to the contrary.

Since all active composition components herein are known to useful in antimicrobial compositions, it is considered prima facie obvious to combine them into a single composition to form a third composition useful for the very same purpose. At least additive therapeutic effects would have been reasonably expected based on the well settled principle set forth *In re Kerkhoven* regarding combination inventions. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Keller*, 642 F.2d 413, 208 SPQ 871 (CCPA 1981); *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). See MPEP 2145.

Therefore, motivation to combine the teachings of the prior art cited herein to make the present invention is seen. The claimed invention is clearly obvious in view of the prior art.

As discussed in the previous Office Action March 26, 2002, Applicant's testing data and remarks regarding the results herein on the 2-part systems in the specification have been fully considered with respect to the nonobviousness and/or unexpected results of the claimed invention over the prior art but are not deemed persuasive as discussed below. The testing results on 2-part systems herein provide no clear and

Art Unit: 1617

convincing evidence of nonobviousness or unexpected results over the prior art since the specification provides no side-by-side comparison with the closest prior art, Andrews' patent (5,460,833), in support of nonobviousness for the instant claimed invention over the prior art. It is noted that the conditions for testing on antimicrobial activity in Andrews are different from the conditions herein, e.g., temperature and time. Therefore, the evidence presented in specification herein is not seen to support the nonobviousness of the instant claimed invention over the prior art.

For the above stated reasons, said claims are properly rejected under 35 U.S.C. 103(a). Therefore, said rejection is adhered to.

In view of the rejections to the pending claims set forth above, no claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (703) 305-1008. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-1235.

S. Anna Jiang, Ph.D.
Patent Examiner, AU 1617
January 15, 2003



SREENI PADMANABHAN
PRIMARY EXAMINER

1/26/03